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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,042	10/03/2001	Unni Olsbye	2001-0768A	2508

513 7590 02/21/2003

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EXAMINER

ILDEBRANDO, CHRISTINA A

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 02/21/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/869,042	<b>Applicant(s)</b> OLSBYE ET AL.
	<b>Examiner</b> Christina Ildebrando	<b>Art Unit</b> 1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 03 October 2001.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-43 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 and 26-43 is/are rejected.

7) Claim(s) 21-25 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1, 2, and 30-32 are objected to because of the following informalities: claims 1 and 2, "it's" should be "its"; claims 30-32, "periodical" should be "periodic". Appropriate correction is required.
2. Claims 21-25 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 21-25 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 6 and 38-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 6 recites the limitation "wherein M<sup>3+</sup> is further Ga." No components have been defined for M<sup>3+</sup>. Therefore, it is not clear what applicant intends by "further Ga."
6. Claims 38-43 provides for the use of a catalyst composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Also, 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 38-43 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Claim Rejections - 35 USC § 102/103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

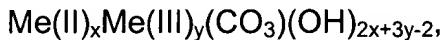
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5, 7-20, 26-29, 32, 36<sub>29</sub> or 32, and 38-43 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Derouane et al.

Derouane et al. (US 5,245,096) discloses a catalyst composition useful in the preparation of aromatic compounds. The catalyst comprises a Group VIII metal loaded on a hydrotalcite derived support material having the general formula:



wherein Me(II) is at least one divalent metal selected from the group consisting of copper, magnesium, manganese, zinc, and group VIII metals and Me(III) is at least one trivalent metal selected from the group consisting of aluminum, chromium, and iron (column 1, lines 45-55). Suitable Group VIII metals include platinum (column 3, lines 30-35). The composition may be composited with a binder (column 3, lines 60-69).

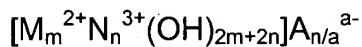
Regarding claims 38-43, it is well settled that terms merely setting forth intended use for an otherwise old composition do not differentiate the claimed composition from those disclosed in the prior art. *In re Pearson*, 181 USPQ 641. Also. "it is contrary to spirit and patent laws that patents be granted for old compositions of matter based on new uses of compositions were uses consist merely in employment of compositions; patentee is entitled to every use of which invention is susceptible, whether such use be known or unknown to him." *In re Thuau*, 57 USPQ 324.

The disclosed product of Derouane et al. and the instantly claimed product appear to be essentially the same and are comprised of the same components. In the event any differences can be shown for the product of the product-by-process claims as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed.

Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

10. Claims 1-20, 26-29, 32, 36<sub>29 or 32</sub>, and 38-43 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Broekhoven.

Van Broekhoven (US 4,866,019) discloses a catalyst composition useful in hydrocarbon conversion processes. The catalyst composition comprises an anionic clay having a hydrotalcite structure, corresponding to the general formula:



Suitable divalent cations include magnesium, suitable trivalent cations include aluminum and/or gallium, and suitable anions include OH or CO<sub>3</sub> (column 3, lines 20-45). The composition may be combined with an oxidation promoter such as platinum (column 4, lines 1-10). The composition may be composited with a binder (column 5, lines 40-46).

Regarding claims 38-43, it is well settled that terms merely setting forth intended use for an otherwise old composition do not differentiate the claimed composition from those disclosed in the prior art. *In re Pearson*, 181 USPQ 641. Also, "it is contrary to spirit and patent laws that patents be granted for old compositions of matter based on new uses of compositions were uses consist merely in employment of compositions;

patentee is entitled to every use of which invention is susceptible, whether such use be known or unknown to him." *In re Thuau*, 57 USPQ 324.

The disclosed product of Van Broekhoven and the instantly claimed product appear to be essentially the same and are comprised of the same components. In the event any differences can be shown for the product of the product-by-process claims as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

11. Claims 1-5, 7-20, and 26-43 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 94/29021.

WO 94/29021 teaches a catalyst composition useful in the dehydrogenation of paraffinic hydrocarbons. The catalyst composition comprises a hydrotalcite having a composition  $Mg_6Al_2(OH)_{16}CO_34H_2O$  in its uncalcined state, which further contains a metal of group VIII such as platinum, a metal of group IV such as tin, and optionally, a group I metal such as cesium (page 2, lines 20-40 and page 3, lines 25-30).

Regarding claims 38-43, it is well settled that terms merely setting forth intended use for an otherwise old composition do not differentiate the claimed composition from those disclosed in the prior art. *In re Pearson*, 181 USPQ 641. Also, "it is contrary to

spirit and patent laws that patents be granted for old compositions of matter based on new uses of compositions were uses consist merely in employment of compositions; patentee is entitled to every use of which invention is susceptible, whether such use be known or unknown to him." *In re Thuau*, 57 USPQ 324.

The disclosed product of the WO reference and the instantly claimed product appear to be essentially the same and are comprised of the same components. In the event any differences can be shown for the product of the product-by-process claims as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Ildebrando whose telephone number is (703) 305-0469. The examiner can normally be reached on Monday-Friday, 7:30-5, with Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (703) 308-3318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

CAI  
February 12, 2003

*Tom Dunn*  
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